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10/506,294	08/31/2004	Johannes Lenkl	53376/DBP/E43	3215
23363	7590	11/30/2006	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			OSELE, MARK A	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	
			1734	
DATE MAILED: 11/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/506,294

Applicant(s)

LENKL, JOHANNES

Examiner

Mark A. Osele

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The claim states "wherein the applicator head is reversibly displaceable in a straight line from a starting position into an applicator position, and wherein the applicator pad can be reversibly inserted into a pad receiving means in a direction transverse to the straight line." Upon review of the application, similar language was discovered in the "Summary" portion of the application, but there is no description of this feature in sufficient detail to ascertain the scope and meaning of the claim.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 7-9 are generally narrative and indefinite, failing to conform with current U.S. practice. The intended scope of the claim is unclear because the specification fails to detail the claimed features.

6. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. It appears to be a literal translation into English from a foreign document and contains grammatical and idiomatic errors. Applicant's amendment made the claims a bit clearer, but it is requested applicant review the claim language again, because there is some inconsistency in the claim language used.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 6, 10, 13, 15-17, 19, 20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Hofe (US Patent No. 2,492,908).

Regarding claim 1, Von Hofe discloses an applicator head for a device which is in communication with an air suction source and also includes at least two perforatable, weak locations on the surface. The applicator in Von Hofe includes a shim (45). (Col. 5, line 51 through Col. 6, line 27.)

As to claims 2 and 3, Figures 3 and 5 show how the weak locations are regularly arranged over the entire applicator surface.

As to claim 4, Figure 6 shows grooves on the outside of the applicator surface.

As to claims 6, 10, 13, and 15, Von Hofe includes an embodiment where an applicator pad (39) is coupled to the applicator surface of the shim (41). (See Figure 2.) Also included is a mounting frame (36) releasably connected to the applicator pad (39). The surface of the mounting frame includes perforated or weak locations (42) which correspond to the ones on the shim (41).

As to claim 16, the carrier plate in Von Hofe has a sufficient thickness.

As to claim 17, the carrier plate is releasably connected to the air suction force.

As to claim 19 and 20, the formation in Figures 3 and 5 show a pattern of closely spaced dots that amounts to a raster grid with rows and columns.

As to claim 22, the applicator plate includes an applicator surface in Van Hofe.

As to claim 23, the embodiment with the carrier plate and applicator plate in Figure 2 includes a space in between.

9. Claims 1-5, 13, 15, 18, 21, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Becker (US Patent No. 6,182,957 B1).

Regarding claim 1, Becker discloses an apparatus for holding a flexible product which is in communication with an air suction source and also includes at least two perforatable, weak locations on the surface. In Becker the flat plate (14) includes apertures (22) which extend through the plate. It is appreciated that these apertures are weak locations, alternatively a tool which is made of harder material than the plate can be used to perforate the plate at the location of the apertures or make new apertures in the plate.

As to claims 2 and 3, Figure 3 shows how the weak locations are regularly arranged over the entire applicator surface.

As to claims 4, 5, and 21, a second plate (16) is fastened to the flat plate (14) and provides for columns and grooves which are provided between at least two columns of the weak locations as shown in Figure 1. The grooves extend in parallel and at equidistant spacing to each other.

As to claim 13, Becker includes an applicator plate (16) and a carrier plate (14).

As to claim 15, the applicator plate includes grooves which are considered weakened locations which are aligned with the weakened locations (22) on the carrier plate (14).

As to claims 18 and 26, the material used in Becker is plastic material, and plastic materials are known to be deformable.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hofe as applied to claims 1, 6, and 10 above, and further in view of Tiefel (US Patent No. 5,885,406).

While Von Hofe shows applicator pad with a mounting frame, there is no teaching in Von Hofe with respect to a locking device which includes a spring-loaded ball. It would have been obvious to one having ordinary skill in the art at the time the invention was made that such a locking device could be used in the device of Von Hofe, because, as shown in Tiefel, such a locking device is known in the art and within the purview of one of ordinary skill to use as needed.

12. Claims 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hofe as applied to claims 1 and 13 above, and further in view of Wood (US Patent No. 3,377,096) or Wilson et al. (US Patent No. 5,024,574).

Von Hofe discloses releasably attaching the applicator plate and the carrier plate. Alternatively the plates could be non-releasably fastened together as shown in both Wood and Wilson. It would have been obvious to one having ordinary skill in the art at the time the invention was made to non-releasably fasten plates together by means of glue, because Wood and Wilson show that it is well known to glue surfaces together

Art Unit: 1734

which multiple plates are used in combination on a vacuum chuck. Using glue to adhere the plates together is a functionally equivalent alternative expedient of using fasteners, both being within the purview of the artisan.

### ***Allowable Subject Matter***

13. Claim 25 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

14. Applicant's arguments filed September 13, 2006 have been fully considered but they are not persuasive.

Regarding applicant's arguments that the substitute specification meets the written restriction requirement, it is reiterated that although the language in the claims is found in the specification, the scope and meaning of the claim is not ascertainable. One of ordinary skill in the art would not know in which direction the applicator head is displaceable.

Regarding applicant's arguments that the claims are understandable, the claims are not written in standard U.S. Patent claim language. Examples of idiomatic language which is indefinite or unclear are: claim 1, line 3, "...surface in air communication with..." and claim 16, line 2, "...of a thickness that allows a removal of material for adapting the applicator's surface to the flat material element."



Regarding applicant's arguments against Von Hofe, the perforatable, weak locations are those locations in the shim that correspond to the bores, 42, in the mounting frame as these are the only locations that are perforatable when the shim is clamped between the mounting frame and the applicator pad. In this configuration, the raster grid of rows and columns shown in Figs. 3 and 5 shows the arrangement of weak locations where the shim can be perforated by a drill or punch. The rest of the shim is not perforatable and weak as it is sandwiched between two thick, solid materials (See in particular Column 6, lines 12-27). Applicant's analysis of perforatable, weak locations being "locations of a reduced thickness when compared to the rest of the plate," is one possible way perforatable locations can be achieved, but is not a limitation currently claimed.

As to applicant's argument that the shim of Von Hofe is an applicator surface as it is located behind plate 39, claim 6 indicates that an applicator pad is coupled to the applicator's surface. In this way, the applicator surface of the instant invention is also located behind an applicator plate.

Regarding the argument that Von Hofe fails to show the applicator plate having a thickness that allows a removal of material for adapting the applicator's surface to the flat material element, Fig. 4 shows the shim to have a cut out section corresponding to the shape of the label.

Regarding applicant's arguments against Becker, it is reiterated that applicant's analysis of perforatable, weak locations being "locations of a reduced thickness when compared to the rest of the plate," is one possible way perforatable locations can be

Art Unit: 1734

achieved, but is not a limitation currently claimed. Again, the thin plate, 14, of Becker when attached to the thicker plate, 16, has perforatable areas only in association with the holes in the thicker plate, 16.

***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Mark A. Osele', written in a cursive style.

**MARK A. OSELE  
PRIMARY EXAMINER**

November 27, 2006